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Applicants: Stewart et al.

Examiner: Queler, Adam M.

Title: System, method and recordable  
medium for printing services over a  
network and graphical user interface

Docket No.: MIME-0003

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Commissioner for Patents  
P.O. Box 1450  
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**REQUEST FOR REHEARING**

Sir:

This paper is being filed in response to the Decision on Appeal dated 2 November 2011. Appellants thank the Board for its consideration and reversals of the Examiner's rejections of claims 41; and 13, 14, and 37-40. However, Appellants request reconsideration of the rejections of claims 12, 20, 24, 31, and 42 for the following reasons.

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## Table of Authorities

1. *In re Stepan Co.*, Appeal No. 2010-1261, decided 5 October 2011 (Fed. Cir. 2011).

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2. *Superguide Corp. vs. DirecTV Enterprises, Inc.*, 358 F.3d 870, 69 USPQ2D (BNA)

1865 (Fed. Cir. 2004). .... p. 8

## Argument

### Claim 12

On p. 9, lines 4-15 of the Board's opinion, the Board states, when addressing claim 12, "that Appellants recite the entirety of the 'providing system software for use on a client' clause of claim 12, but ignore the 'configured to at least one of:' language recited in the claim." Decision on Appeal, p. 9, lines 4-7. The Board further states that a broad but reasonable construction of claim 12 requires the Examiner to show only one of the recited alternatives. *Id.* at lines 7-9. The Board concludes that the Examiner has shown "wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document..." *Id.* at lines 9-15.

In the providing system software clause of claim 12, the "configured to at least one of" language was not explicitly addressed in the arguments since it clearly pertains to the application, and not directly to the system software at issue in the rejection of claim 12. Inclusion of the configured to at least one of clause makes explicit that the user uses the print request feature of an application typically used to view and/or edit a document (e.g., a word processor) to request to remotely print the document.

Appellants respectfully request reconsideration of the Board's sustaining the Examiner's rejection for the following reasons:

A. The Board sustained the Examiner's rejection based on a new ground of rejection.

Initially, Appellants note that the Examiner did not interpret the claim in the same manner as the Board. In contrast, the Examiner proposes that a combination of the two embodiments of Adamske and Tonkin teaches all of the claimed acts. See, e.g., Examiner's Answer, pp. 6-8 and 23-24. The Examiner never contends that the "configured to at least one of" language only requires a showing of one of a group of alternatives. *Id.* As a result, the Board's decision sustaining the Examiner's rejection constitutes a new ground of rejection. See *In re Stepan Co.*, Appeal No. 2010-1261, decided 5 October 2011 (Fed. Cir. 2011) holding that "the Board's sustaining an examiner's obviousness rejection under a wholly different basis than that relied upon by the examiner... constitutes a new ground of rejection." *In re Stepan*, p. 5. As a result, Appellants are entitled to reconsideration from the Board and request that the Board explicitly designate its sustaining of the Examiner's rejection of claim 12 as a new ground of rejection. *Id.* at p. 6.

B. Appellants respectfully submit that the Board's analysis is inaccurate for one or more of three alternative reasons.

1. The Board's construction of the providing system software clause of claim 12 is not grammatically correct and renders the clause meaningless.

The entire providing system software clause of claim 12 reads:

providing system software for use on a client, wherein the system software allows a user of the client to use **an application configured to at least one of: display or edit the document** to request to remotely print the document, and, in response to the request and without user-initiated

interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file. (claim 12, emphasis added)

Appellants respectfully submit that the "configured to at least one of" clause explicitly states functionality of the application since the clause is immediately preceded by the noun "an application." As a result, the "configured to at least one of" language does not directly address the acts provided by the system software, but rather relates to the application being used by the user of the client.

Furthermore, the scope of the "at least one of" clause is limited to the first list of alternatives described immediately thereafter, namely, "display or edit the document." In the Board's interpretation of the claim, the list of alternatives is incorrectly grouped together with additional language as a single "alternative."

By grouping the first list of alternatives together as a single alternative, the Board's construction causes the claim to lack internal consistency. In particular, under the Board's grouping, the at least one of clause includes two alternatives: "display or edit the document to request to remotely print the document" and "in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file." In this case, the second alternative refers back to the first alternative and is done "in response to" occurrence of the first alternative. As a result, the two "alternatives" are not coequal members of a list. Rather, one "alternative" is explicitly

done in response to the other "alternative." Appellants submit that such a grammatical construction is not reasonable.

2. The Board's construction of the providing system software clause of claim 12 is not reasonable when viewed in light of the specification.

As discussed above, under the Board's grouping, the remainder of the providing system software clause following the "configured to at least one of" language necessarily would pertain to the application, and not the system software, since the remainder of the clause would be included in a list of two alternatives for the "at least one of" clause.

Appellants submit that such an interpretation of the providing system software clause is not reasonably supported by the specification. For example, the specification does not describe providing any type of system software for allowing a user of the client to use a particularly configured application. In contrast, the specification describes a local application used to create a document and downloadable system software (e.g., a print driver and upload manager) for generating a print file, transmitting the print file to a server, and prompting a user to configure and preview a bound copy of the document. See, e.g., Specification, FIGS. 2 and 3, pp. 11, line 16-p. 12, line 17; FIG. 7, p. 17, lines 10-17; and FIGS. 13, 14A-14I, and 15A-15K, pp. 22, line 8-p. 23, line 14.

3. The Board's construction of the providing system software clause of claim 12 requires consideration of all of the elements in the list.

Even if, *arguendo*, the "configured to at least one of" language applies to a list including the two clauses, Appellants note that the two clauses of the list are separated in claim 12 by the conjunction "and."

As the Federal Circuit held in the *Superguide Corp. vs. DirecTV Enterprises, Inc.*, 358 F.3d 870, 69 USPQ2D (BNA) 1865 (Fed. Cir. 2004) decision, "at least one of" followed by a list of categories separated by the term "and" requires each element in the list be fulfilled. In particular, the *Superguide* Court held that "[t]he phrase 'at least one of' precedes a series of categories of criteria, and the patentee used the term 'and' to separate the categories of criteria, which connotes a conjunctive list... [t]herefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category." *Superguide*, 358 F.3d 870, 69 USPQ2D (BNA) 1865. As a result, even under the Board's proposed construction of the providing system software clause of claim 12, the Board cannot halt its analysis of the features of claim 12 after finding that "the Examiner show only one of the recited alternatives." To the contrary, since the clauses are included in a conjunctive list separated by the term "and," the list requires that the Examiner show each of the clauses.

C. Appellants further request the Board's consideration of all of the features of claim 12 based on equitable grounds.

As discussed above, the "configured to at least one of" language pertains to the application, and not the system software at issue in the rejection of claim 12. As a



result, Appellants can readily remedy the grounds for rejection by removing and/or modifying the "at least one of" language, if necessary. However, the Board's decision does not address the contested grounds on which the Examiner relied in rejecting the claim, namely, the Examiner's contention that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests all of the acts provided by the claimed system software. As a result, should Appellants remove and/or modify the "at least one of" language, Appellants will likely need to appeal to the Board again to resolve the contested grounds on which the Examiner relies in rejecting the claim. Requiring such an additional appeal would unnecessarily prolong the prosecution of this case and delay resolution of the rejections at issue.

Furthermore, Appellants note that this is the second Appeal decision for this case in which the Examiner's rejections were sustained on different grounds than those presented by the Examiner. See, e.g., Decision on Appeal dated 18 June 2008 interpreting "font database" as teaching claimed configuration information where Examiner cited "style options" as allegedly teaching claimed configuration information; and interpreting Adamske's application translation server and conversion program as teaching claimed client and system software where Examiner cited print driver program residing on the client in Adamske as allegedly teaching the claimed client and system software.

In light of the above, Appellants respectfully request that the Board consider all of the features of claim 12 in light of the teachings of the proposed combination of the two embodiments of Adamske and Tonkin in order to provide a comprehensive opinion from which further prosecution of this case can proceed in an efficient manner.

### Claims 20, 24, 31, and 42

On p. 13, lines 1-6 (regarding claim 20) and p. 15, lines 12-18 (regarding claims 24, 31, and 42) of the Board's opinion, the Board agrees with the Examiner that Appellants have not specifically pointed out how the language of the claims patentably distinguishes them from the references.

In response, Appellants note that each of the independent claims 20, 24, and 31 includes a substantively very similar "providing system software" clause as that discussed with respect to claim 12. Similarly, claim 42 recites actions substantively very similar to each of the acts described in the providing system software clause of claim 12 as being performed in response to a request to print a document. Additionally, all of these independent claims are rejected using the same proposed combination of references as used in rejecting claim 12.

Appellants note that the arguments presented with respect to claim 12 are equally applicable to each of these claims. To this extent, to present the arguments regarding the contested issues in a clear manner, Appellants reference the previous arguments and the relevant clause of the claims rather than repeating the arguments substantially verbatim six times in the Appeal Brief. See, e.g., argument for claim 20 in which Appellants state "**in view of the discussion** of the proposed combination of the two embodiments of Adamske and Tonkin **above**, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a component configured to preview a document over a network by **providing the system software** claimed therein." Appeal Brief, p. 24. As a result, Appellants respectfully submit that the Appeal Brief includes sufficient arguments to

comply with 37 CFR 1.111(b) by first referencing the previously stated arguments and identifying the language of the claims that patentably distinguishes each from the proposed combination of references.

Furthermore, even if, *arguendo*, Appellants' arguments are insufficient, Appellants respectfully submit that should the Board reverse the rejection of claim 12, the Board also must reverse the rejections of each of these claims since the Examiner will have also failed to show that the same proposed combination of references teaches or suggests, *inter alia*, the same or a substantively very similar feature.

## **Conclusion**

In summary, Appellants respectfully request reconsideration of the rejections of independent claims 12, 20, 24, 31, and 42 and submit that these claims are allowable over the cited art because the Examiner's use of the proposed combination of the two embodiments of Adamske and Tonkin fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art and the Board's previous construction and/or analysis of these independent claims is deficient for the reasons stated herein.

Respectfully submitted,

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